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Supreme Court of the United States

October Term, 1973

No. 73-670

THE TRIAX COMPANY,
Petitioner,

v.

HARTMAN METAL FABRICATORS, INC.,
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals
For the Second Circuit

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The Triax Company petitions the Court to issue its writ of certiorari to the United States Court of Appeals for the Second Circuit to review the judgment entered by that court in Causes No. 71-1843 and 71-1978 on its docket, and in support thereof says:

OPINIONS BELOW

The opinion of the District Court (by Judge Harold P. Burke in the Western District of New York at Rochester) is not reported but appears in the Appendix hereto, under separate cover, at page 1; the opinion of the United States Court of Appeals for the Second Circuit (by Judge Waterman, concurred in by Judges Friendly and Hays) is reported in 479 F.2d 951 and 178 USPQ 142 and is printed in the Appendix hereto at page 11.

JURISDICTION

The judgment sought to be reviewed is dated and was entered May 31, 1973; rehearing was denied July 23, 1973. This Court has jurisdiction to review pursuant to 28 U.S.C. 1254 (1) and 2101 (c).

QUESTION PRESENTED

This case brings to this Court the question:

> Whether the statutory requirement of 35 U.S.C. 282 that "A patent shall be presumed valid" has been improperly rejected.

CONSTITUTIONAL PROVISION AND STATUTES

The constitutional and statutory provisions relevant to the case are:

Constitution, Article I, Section VIII

"The Congress shall have power * * * To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries * * *."

35 U.S.C. 101, Inventions Patentable

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." July 19, 1952, c. 950, § 1, 66 Stat. 797.

35 U.S.C. 102, Conditions for patentability; novelty and loss of right to patent

"A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

* * * * *

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent * * *." July 19, 1952, c. 950, § 1, 66 Stat. 797.

35 U.S.C. 103, Conditions for patentability; non-obvious subject matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *" July 19, 1952, c. 950, § 1, 66 Stat. 798.

35 U.S.C. 282, Presumption of validity; defenses

"A patent *shall be presumed valid.*[1] The burden of establishing invalidity of a patent shall rest on a party asserting it. * * *" July 19, 1952, c. 950, § 1, 66 Stat. 812.

---

[1]Emphasis supplied throughout.

STATEMENT OF CASE

Petitioner, The Triax Company, a Cleveland concern, was organized in a small way in March, 1956, to explore the possibility of developing equipment to store materials automatically. (Tr. 23.) What was but an idea in 1956 bore fruit three years later in 1959; the first installation of such equipment in the country was in that year made by Triax at the Reliance Electric Company plant in Cleveland.[2] In the 15 years since then the industry has grown to the point where the trade journals project an annual market of $60 million.[3]

The machinery for automatic storage of materials is custom-made to meet the requirements of each user. It has mechanical arms that carry loads as light as greeting cards or as heavy as engines, or machine parts, that weigh in the tons.[4] It automatically transports these loads into, and from, storage bins located in stacks "rising to heights of 100 feet or more, and extending to lengths of from 120 feet to over 800 feet, which are arranged in parallel rows in a large room," 479 F.2d at 952,—*i.e.*, in stacks that rise 10 stories high and extend nearly as far as three football fields, end to end.

The merit of the system is that it is operated "without human attendance," is controlled "from a location remote from" the storage place, permits "maximum storage volume in a given warehousing area," and not needing attending personnel, eliminates need "for lighting or heating," with resultant "substantial economic saving of time and expense * * *."[5]

Triax sued on three patents in the District Court

---

[2] See Material Handling Engineering, July 1959, p. 50.

[3] Modern Materials Handling, Guidebook No. 3, July 1973, p. 52.

[4] See Western Material Handling, June 1959, p. 14.

[5] PX 25, R. Vol. II, p. 58.

(pursuant to 28 U.S.C. 1338 (a)), namely *Lemelson*, U.S. No. 3,119,501 (held valid by both courts below but not infringed), the *Chasar "Dual-Command"* Patent, U.S. No. 3,139,994, and *Chasar "Load-Height"* Patent, U.S. No. 3,219,207 (both held valid by the trial court and invalid as "obvious" by the Court of Appeals).

Petitioner Triax brings to this Court only the Chasar "Dual-Command" patent, because as to it the Court of Appeals gave an important standard of patent law an interpretation that merits the attention of this Court, *viz.*:

Statutory Presumption of Validity Has Been Improperly Rejected

The presumption of validity that 35 U.S.C. 282 commands be accorded a patent, the Court of Appeals, by twofold mistake, deemed "severely undercut" (479 F.2d at 954), *viz.*:

(a) *The Court of Appeals erroneously supposed* a prior Chasar patent and a British Stirling patent were *not* disclosed in the file wrapper of the Chasar dual-command patent. 479 F.2d at 954.

The Court erred.

The prior Chasar *was disclosed and discussed.*[6] The *British* Stirling was not cited, *but the identical invention* disclosed in the companion *French* Stirling, *was disclosed and discussed.* The invention of the British Stirling was thus before the Patent Office and was considered by it.[7]

(b) *The Court of Appeals erroneously supposed* the earlier Chasar *"discloses the same* storage-retrieval machine * * *." 479 F.2d at 955. The Court of Appeals

[6] R. Vol. II, p. 22; PX 45, p. 212, R. Vol. I, p. 151.
[7] PX 45, pp. 235, 237, 250-251, R. Vol. I, p. 130.

missed the point: the contribution of the Chasar dual-command patent is to permit *two* errands to be run by the same machine through use of a *single electrical control circuit* that may be automatically interrupted to perform a second command and automatically re-established to complete the dual command. That this could be achieved *with a single circuit* is not even hinted in the earlier Chasar or in any other prior-art patent. Chasar, so to speak, thus made "two blades of grass to grow * * * where only one grew before," and the inventor, therefore, as Swift put it[8] should "deserve better of mankind," for he has rendered "essential service to his country * * *."

The Court of Appeals thus erroneously short-circuited the statutory presumption of 35 U.S.C. 282 and thereby destroyed a valuable property right.

REASONS FOR GRANT OF WRIT

This Court should take this case:

1. *To determine whether the constitutional provision* for grant of a patent "To promote the progress of science and the useful arts" deserves to be relegated to second-class status among constitutional guarantees.

2. *To determine whether the statutory presumption of validity* is an idle gesture, permitting a patent important to a new industry, adjudged valid by the trial court, to be deemed "obvious" by the reviewing court in the mistaken belief that the Patent Office was ignorant of prior patents which, the Court of Appeals failed to notice, *were cited and considered* by the Patent Office and over which the Patent Office ruled the invention in suit distinguished.

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[8] In *A Voyage to Brobdingnag.*

CONCLUSION

The writ should issue.

Respectfully submitted,

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APPENDIX TO PETITION FOR WRIT OF CERTIORARI

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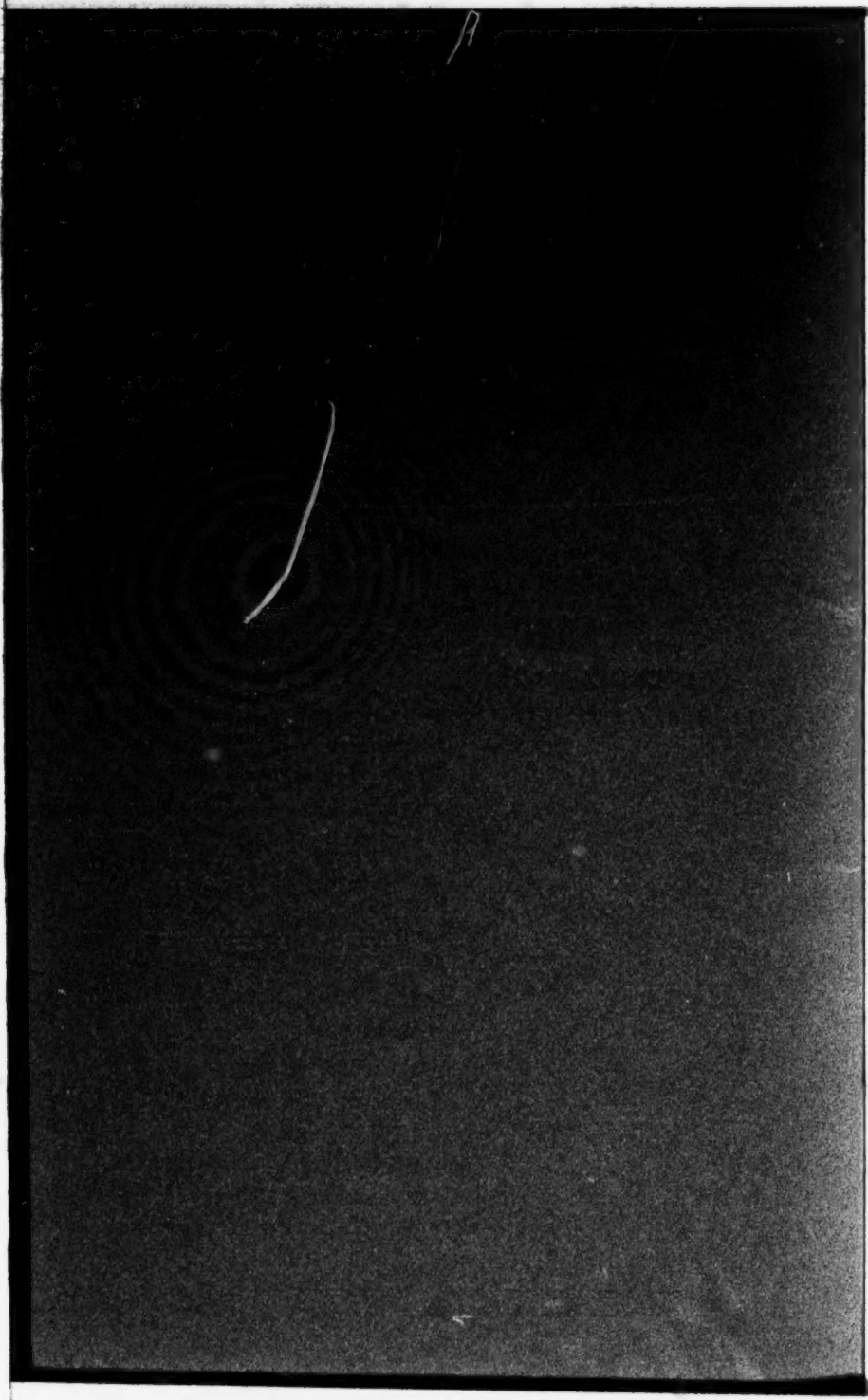

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I. TRIAL COURT'S FINDINGS OF FACT AND CONCLUSIONS OF LAW

CIVIL 11,210 AND 11,860 CONSOLIDATED

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF NEW YORK

THE TRIAX COMPANY,
Plaintiff,

vs.

HARTMAN METAL FABRICATORS, INC.,
Defendant.

Trial before the undersigned at Rochester, N.Y., January 20, 21, 22, February 26 and 27, 1970.

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FINDINGS OF FACT

1. Plaintiff, The Triax Company, is an Ohio corporation. Its principal place of business is at Euclid, Ohio. Defendant, Hartman Metal Fabricators, Inc., is a New York corporation. It has its principal place of business at Victor, New York.

2. Plaintiff is the owner of the entire right, title and interest of U. S. Letters Patent No. 3,119,501 issued to Jerome H. Lemelson on January 28, 1964 for an "Automatic Warehousing System", and the owner of the entire right, title and interest of U. S. Letters Patent No. 3,139,994 issued to Anthony R. Chasar on July 7, 1964 for "Mechanical Load Handling Transfer and Storage Equipment" upon an application filed in the Patent office November 2, 1960, Ser. No. 66776; and the owner of the entire right, title and interest of U.S. Letters Patent No. 3,219,207 issued to Anthony R. Chasar on November 23, 1965 for "Load Sensing Automatic Storage Apparatus" upon an application filed in the Patent Office July 31, 1963, Ser. No. 299015.

3. The complaint in Civil Action 11,210 was filed December 18, 1964 charging the defendant with infringement of the Lemelson patent and Chasar patent—'994. The complaint in Civil Action 11,860 was filed on January 3, 1966 charging the defendant with infringement of the Chasar patent—'207. On May 6, 1968, these two actions were consolidated for trial.

4. Claims 1, 2 and 6 of the Lemelson patent describe a laterally extending apparatus. Hartman's first generation warehousing apparatus does not have a laterally extending fixture. Hartman's apparatus is capable of extending laterally but this feature is not the same or the equivalent of Lemelson's laterally extending fixture which always extends. Hartman's laterally extensible apparatus is normally housed within the elevator. Lemelson's laterally extending fixture requires a wider aisle for movement than is required by Hartman's apparatus because Lemelson's fixture always extends laterally. When Hartman's stacker is moved down the aisle, his load supporting fixture is within the stacker. Lemelson's apparatus is

only capable of servicing one side of an aisle with his laterally extending fixture. Lemelson is required to duplicate his structure to service both sides of an aisle, or to provide some means for rotating his stacker. Hartman's loader can be extended out of either side of his stacker to service the racks at both sides of an aisle. In the stacker 30 of fig. 1 of the Lemelson patent, the forks 36 do not have the capability of lateral extension. Movement of the load into or out of a bin is accomplished by movement of the stacker bodily. The Lemelson patent is not to be construed, as plaintiff contends, as disclosing means for rotating the fork lift or stacker to service storage racks on both sides of an aisle, because Lemelson's abandoned patent application filed July 28, 1954 disclosed such means. Such disclosure contained in the abandoned Lemelson application is not relevant to this suit because it was abandoned. The structure disclosed in the Lemelson patent can not service both sides of an aisle. Lemelson's claims do not call for the load carrier to service both sides of an aisle, but Lemelson's laterally extending fixture, always laterally extending, is a distinct limiting feature in claims 1, 2 and 6, which may not be disregarded.

5. Claim 1 of the Lemelson patent specifies means on the storage racks for identifying the relative positions of the storage bays. Hartman's first generation machines have no means on the storage racks for identifying the relative positions of the storage bays. The vertical position at which Hartman's load carrier is to stop for depositing a load in, or picking up a load from, a storage bay is determined by pins on an endless chain that raises or lowers the elevator on which the load carrier is mounted. The pins engage and trip a switch on the stacker mast. The chain and its pins are not mounted on the storage racks but are carried by the stacker. They are not

attached in any way to the storage racks. A second switch on the stacker engages spaced transverse bars that extend between two racks at opposite sides of the aisle, to identify the column of bins at which the horizontal movement of the stacker is to stop. Hartman's first generation apparatus does not have item (i) of claim 1 of the Lemelson patent, nor its equivalent.

6. Hartman's load carrier has a diagonal motion in travelling to a bin to deposit or to pick up a load. It does not travel horizontally first, then stop, and then travel vertically to the selected bin and stop. It simultaneously travels horizontally and vertically. Because of this diagonal motion it is impossible for Hartman to use means on the storage racks for identifying the relative positions of the storage bays, because of the different angles presented by diagonal travel.

7. Claims 1, 2 and 6 specify scanning relay means mounted on the self-propelled conveyor for scanning said identifying means. As shown above, Hartman has pins on an endless chain that raises and lowers the elevator (not on the elevator itself) that engage and trip a switch on the stacker to determine the height to which the elevator is raised or lowered. Hartman uses no scanning relay means for this purpose. Hartman has transverse bars between opposed storage rack frames that are engaged by a switch on the stacker to determine the position of the stacker longitudinally in the aisle.

8. Hartman has no predetermining counting relay means, which stops the drive means upon receipt of a predetermined number of position indicating signals.

9. For the above reasons, Hartman's apparatus does not infringe claims 1, 2 and 6 of the Lemelson patent.

10. Claims 1 and 8 of the Chasar patent '994 in effect call for a cycle in which the carrier normally returns to the pick-up-and-discharge station after execution of a first command, but in which the cycle is deactivated or interrupted before the carrier returns to the pick-up-and-discharge station and the cycle is then again activated to execute the second command. The carrier of the '994 patent has to move backwardly toward the pick-up-and-discharge station after execution of a first command, before it can execute the second command. This backward movement is required because it is necessary in the '994 apparatus to trip an LS 18 switch before the second command can be initiated. This switch can only be tripped by backward movement of the carrier toward home. Claims 1 and 8 of the '994 patent are directed to the structure disclosed in the '994 patent. There is no movement of the carrier toward the load station in any of Hartman's four generations equipment after completion of a first command and before execution of the second command. In Hartman's machines, after the apparatus has completed a first command, the stacker or carrier moves directly to execute the second command, the stacker and elevator moving simultaneously horizontally and vertically to accomplish diagonal motion. There is no backward motion.

11. Hartman's carrier does not go back to the pick-up-and-discharge station after completion of the first command in Hartman's first generation equipment, nor does it in the second and third generations of Hartman's apparatus.

12. In Hartman's fourth generation equipment, the stacker is stopped down the aisle after the first command has been executed, unless a manually-operable selector switch is provided on the machine, and the selector switch is set to ON position. There is one exception, viz, Exhibit

P-38 (Hartman's fourth generation), which automatically returns to the load station after completion of the first command. In this machine there is no deactivation or interruption of the cycle between execution of the first and second commands.

13. In the four machines of Hartman's fourth generation, which have manually-operable selector switches, unless the selector switch is in ON position, the apparatus would not return home after execution of the first command. Thus without moving the selector switch manually to the ON position on these four machines, there would be no automatic return of the stacker to the pick-up and load position after execution of a first command. The requirement for automatic return of the stacker to home after execution of the first command is a limitation of claims 1 and 8 of the '994 patent. Another limitation is that the cycle would be deactivated or interrupted after execution of the first command. That feature is not present in any of Hartman's fourth generation machines, or any other Hartman machine.

14. Claims 1 and 8 of the '994 patent relate throughout to movement of the carrier.

15. For the above reasons none of Hartman's fourth generation apparatus infringe claims 1 and 8 of the '994 patent, particularly not the standard fourth generation equipment, not the four machines provided with selector switches, and not the single machine which had no selector switch but in which the stacker would automatically return after execution of the first command.

16. Claim 6 of the Chasar '207 patent is directed to means for preventing a load of excessive height being stored in a rack. In the machine of this patent, and as recited in claim 6, the carrier is normally positioned adja-

cent to the pick-up-and-discharge station. The carrier has an extractor movable horizontally out of the carrier onto the pick-up-and-discharge station for picking up a load and transferring it to the carrier. The carrier has spaced coacting photoelectric cells and a light source positioned where the light source is so disposed that its beam extends transversely to the path of a load moving onto the carrier, so that if the load being moved onto the carrier from the pick-up-and-discharge station is of sufficient height to break the beam, the motion of the extractor is stopped. If the load being carried onto the elevator by the extractor is of a height sufficient to break the light beam, the motion of the extractor is reversed, and instead of the extractor returning to the elevator, it goes back first to the pick-up-and-discharge station to redeposit the load, and only after the load has been redeposited can the extractor return to the elevator.

17. Certain of Hartman's fourth generation stackers are provided with two vertically spaced pairs of photoelectric cell units and associated light sources, which develop two vertically spaced light beams transversely of the opening through which a load passes upon being brought aboard the stacker from a load station for deposit into a bin which has already been selected by the program card. These two beams correspond, respectively, to low and high bins in the associated racks. They are used to detect or discriminate between loads being brought aboard the stacker. If a low bin has been selected for deposit of a load, and a high load is being brought aboard the stacker from the load station for deposit, the two beams are blocked as the load is moved aboard the stacker. This tells the stacker the load will not fit in the selected bin. After the load has been moved aboard the stacker, the program is rejected and the load remains on the stacker, until a new

program is entered. The breaking of the two beams does not stop the motion of the extractor. It brings the high load aboard the elevator before it stops.

18. There is only one installation in all of Hartman's second, third and fourth generations equipment in which load height sensing apparatus causes the extractor to stop. This is the General Electric installation (Exhibit P-41). The General Electric apparatus is the only one of Hartman's machines in which the extractor would stop immediately if the load were too high. The General Electric installation has four load stations. The carrier would not normally be positioned at any one of them. When the General Electric stacker has completed a command it remains down the aisle wherever it had stored a load. It would not be adjacent to any pick-up-and-discharge station. The operation of Hartman's photocell circuits is not the same or the equivalent of the invention claimed in claim 6 of the '207 patent. Hartman has not appropriated plaintiff's invention as defined in claim 6 of the '207 patent.

19. For the above reasons, Hartman has not infringed claim 6 of the Chasar '207 patent in any of his machines, not even in the General Electric installation.

20. The Lemelson patent is not invalid, as claimed by the defendant, because the disclosure was incomplete and inoperative as shown by the history of its prosecution in the patent office and by the asserted fact that plaintiff's expert, Schultz, found it necessary at the trial to add to the disclosure. Claims 1, 2 and 6 of the Lemelson patent are not invalid as claimed by the defendant because the claimed subject matter would have been obvious to a person ordinarily skilled in the art from the disclosure of Lontz U. S. Patent No. 2,691,448 and other prior art.

21. Claims 1 and 8 of the Chasar '994 patent are not invalid, as claimed by the defendant, because the claimed subject matter would have been obvious to a person ordinarily skilled in the art, particularly from the disclosure of the Burke U. S. Patent No. 2,941,738, the Stirling French Patent No. 1,227,258 and the companion Stirling British Patent No. 866,107, and the Chasar et al U. S. Patent No. 3,132,753.

22. Claim 6 of the Chasar '207 patent is not invalid, as claimed by the defendant, because the claimed subject matter would have been obvious to one ordinarily skilled in the art, and because it fails to define the alleged invention with the particularity and distinctness required by 35 U.S.C. 112.

23. Claims 2, 3, 7 and 9 of the Chasar '994 patent were withdrawn from suit by the plaintiff at the trial.

24. Claims 15 and 16 of the Chasar '207 patent were withdrawn from suit by the plaintiff at the trial.

CONCLUSIONS OF LAW

1. The Lemelson patent in suit No. 3,119,501, including claims 1, 2 and 6, is a valid patent. The defendant has not infringed any of claims 1, 2 and 6 of the Lemelson Patent by the manufacture, use or sale of its warehousing equipment.

2. The Chasar Patent No. 3,139,994 is a valid patent. The defendant has not infringed claims 1 and 8 of the '994 patent by the manfacture, use or sale of its automatic warehousing equipment.

3. The Chasar Patent No. 3,219,207 is a valid patent. The defendant has not infringed claim 6 of the Chasar '207 patent by the manufacture, use or sale of its warehousing equipment.

4. Plaintiff's complaint is dismissed, with prejudice, as to claims 2, 3, 7 and 9 of the Chasar '994 patent, which were withdrawn from suit by plaintiff at the trial.

5. Plaintiff's complaint is dismissed, with prejudice, as to claims 15 and 16 of the Chasar '207 patent, which were withdrawn from suit by plaintiff at the trial.

6. Defendant's application for attorneys' fees is denied.

7. The plaintiff's complaint against the defendant is dismissed on the merits with ordinary costs to the defendant.

/s/ HAROLD P. BURKE
United States District Judge

June 15, 1971

II. OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

479 F.2d 951, 178 USPQ 142

(Argued Nov. 27, 1972. Decided May 31, 1973)

Nos. 35, 36, Dockets 71-1843, 71-1978

UNITED STATES COURT OF APPEALS
SECOND CIRCUIT

THE TRIAX COMPANY,
Plaintiff-Appellant,

vs.

HARTMAN METAL FABRICATORS, INC.,
Defendant-Appellee.

Thomas V. Koykka, Arter & Hadden, Cleveland, Ohio, George S. Baldwin, Richard J. Egan, Robert J. Fetzer, Baldwin, Egan, Walling & Fetzer, Cleveland, Ohio, George W. Shaw, Cumpston, Shaw & Stephens, Rochester, N. Y., for plaintiff-appellant.

B. Edward Shlesinger, Philip K. Fitzsimmons, Shlesinger, Fitzsimmons & Shlesinger, Rochester, N. Y., for defendant-appellee.

Before WATERMAN, FRIENDLY and HAYS, Circuit Judges.

WATERMAN, Circuit Judge:

In this action The Triax Company alleges that three of its patents relating to automatic "stacker" machines it manufactures for use in its patented automated warehous-

ing system were infringed by the "stackers" the defendant Hartman Metal Fabricators, Inc. has manufactured, sold, and installed in warehouses. Hartman defends on the ground that the three Triax patents are invalid for obviousness under 35 U.S.C. § 103; and that, even if they are valid, they are not infringed. The three patents in suit (a Lemelson patent and two Chasar patents) describe an automated warehousing system of the kind in relatively common use among large manufacturing concerns and other types of commercial enterprises. The purpose of the system is to provide an inexpensive and efficient way to handle goods and materials which flow through, and are stored in, warehouses. The typical installation consists of sets of high rise storage racks, rising to heights of 100 feet or more, and extending to lengths of from 120 feet to over 800 feet, which are arranged in parallel rows in a large room. Each set of storage racks consists of two side panels containing a multiplicity of storage bins. The panels are separated by a narrow aisleway that contains a "guide rail" running along the floor of the aisleway or above the aisleway higher than the height of the highest bin. The storage-retrieval machine or "stacker" moves along the aisleway on the guide rail carrying loads to and from specific, pre-selected bins in pre-selected storage racks. The machine is self-propelled; it functions automatically on the basis of programmed instructions which are fed by a control operator into a control panel located on the base of the machine. The design of the stacker is relatively simple: it consists of a "shuttle arm" or shuttle table which extends laterally to pick up and deposit the load; an elevator carriage which raises the load to the proper height (the elevator runs along a "mast" which is a part of the stacker); and the electrical apparatus which controls both the vertical and horizontal automatic movements of the machine. When programmed to deposit a load, the stacker

means was obvious to anyone with ordinary skill in the art.

The same conclusion of invalidity must be reached with respect to the bin reject mechanism—based again on a reading of the earlier Chasar patent (753). Indeed, this mechanism appears to be expressly set out in Claim 4 of that earlier patent:

> Claim 4. A load transfer and storage apparatus as set forth in Claim 1 wherein the recited control means includes means responsive to loads positioned simultaneously on both said selected support means *and said carrier stopping, before collision damage occurs, travel of said laterally extendible frame in the direction of said storage frame,* and means automatically thereafter returning said carrier to said station. (Emphasis added).

Accordingly, we find that both mechanisms in Chasar 994 are invalid for obviousness.

We also agree with Hartman that Claim 6 of Chasar 207 disclosing the photoelectric cell measuring device is invalid for obviousness. Indeed, this kind of device was in such ordinary use that it would have been obvious to almost anybody, not only those skilled in the art. In particular we rely on two patents cited in Hartman's brief (the Macchi U.S. Patent No. 2,118,651, and the Lauterbach U.S. Patent No. 2,366,152) in finding this patent invalid. Neither of these patents was disclosed in the 207 file wrapper.

Macchi claims a system for automatically controlling the feeding of coal into a furnace in order to maintain a predetermined coal level. The system employs a photoelectric cell measuring device whereby a light source is emitted within the furnace in the direction of the coal. When the level of the coal is so high that it intercepts the light beam, the photoelectric cell is effected to deenergize

the feed motor, thereby stopping further delivery of coal into the furnace. The Lauterbach patent discloses a method for measuring the height and width of railroad cars by the use of an "evil eye" light source and photoelectric cell measuring device. When the height or width of the cars breaks the beam the photoelectric cell causes a warning signal to be set off, and the car which triggers the warning signal is thereby identified as being too high or too wide to negotiate a pre-selected railroad route.

Although we are mindful of the dangers of hindsight in declaring a patented device "obvious," we think the load height measuring means of Chasar 207 was clearly anticipated by these two patents. The use of a light beam in combination wtih a photoelectric cell to measure heights is specifically disclosed in both the Macchi and Lauterbach patents, as is also the means by which the extracting device is automatically deenergized through reaction with the photoelectric cell. Accordingly, we find that Chasar 207 is invalid.

Lemelson 501—Is It Valid?

Essentially, Hartman argues that this patent (Claims 1, 2, and 6) is invalid for three reasons: that new matter (Figure 25) was introduced into the original application in violation of the Patent Statute (35 U.S.C. § 132) and the Rules of Practice of the Patent Office (Rule 1.118);[4] that, in violation of 35 U.S.C. § 112[5] the patent does not

[4] Although in its brief Hartman does not cite which rule it claims was violated, we assume it was Rule 1.118 which corresponds to 35 U.S.C. § 132. This section states, in pertinent part: ". . . No amendment shall introduce new matter into the disclosure of the invention."

[5] This section states, in pertinent part:

§ 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making

(Footnote continued on following page)

positions itself by the side of a loading platform, its home station for pickup or discharge, which is located at one end of an aisleway having columns of high rise storage racks on either side thereof. When so positioned, the shuttle arm or table, upon receiving the programmer's command, extends out under the materials programmed for storage, lifts the materials from the loading platform, and then retracts. Having acquired its load the stacker automatically moves away from the loading platform in a horizontal direction down the aisleway. When it reaches the proper distance so that it is opposite the pre-selected stack of bins it stops, the loaded shuttle table moves up the mast, stops automatically at the height of the pre-selected bin, and deposits the load there. After warehousing its load the shuttle table moves down the mast, and the stacker returns automatically to the home station loading platform.[1] At this point the stacker can be programmed to perform another command.

The Lemelson patent (No. 3,119,501) covers the elements that constitute the system and particularly covers the electrical apparatus which controls the automatic vertical and horizontal movements of the stacker.

The two Chasar patents (No. 3,139,994 and No. 3,219,207) cover three mechanisms which affect the operational ability of the stacker in various ways. Under the claims of Chasar 994 the stacker can be programmed to perform two commands, a command to load an article into one bin and a command to retrieve an article from another bin, or vice-versa, before it returns to the home loading

[1] The system also works the same way when it is programmed to return a load. Thus the empty stacker moves away from its home loading platform, proceeds in a horizontal direction along the "guide rail" to the pre-selected column of bins, then the elevator carriage rises along the mast to the height of the pre-selected bin, then the extractor extracts the load, and the stacker returns with it to the loading platform.

platform for reprogramming. This ability to perform two commands would appear to be a new feature of the machine; earlier machines had the capability of executing but one command (either a storage command or a retrieval command) before returning to the home loading area. Chasar 994 also claims the mechanism by which the shuttle table of the stacker will automatically retract if the bin into which the article is to be deposited already holds another load. By virtue of this device, collisions between loads are avoided. In Chasar 207 the third mechanism is claimed, an "evil eye" measuring device which measures the height of the load that is to move onto the stacker. If the load is too tall to fit into the pre-selected storage bin the load breaks a light beam emitted by a source located on the stacker, thereby causing a photocell measuring device in the control circuit to stop the stacker's progress.

After a trial in the United States District Court for the Western District of New York, Judge Harold Burke found that all three of the plaintiff's challenged patents were valid, but that none of the patents were infringed by the defendant's accused apparatuses. Plaintiff Triax now appeals the finding that its valid patents were not infringed, and defendant Hartman cross-appeals the finding of the patents' validity. For reasons which follow, we hold that the two Chasar patents which the lower court found to be valid are invalid for obviousness, and we agree with the lower court that the Lemelson patent is valid, but, although valid, has not been infringed. Accordingly, we affirm the judgment below in defendant's favor, although we affirm for different reasons from those relied upon by the trial court when it entered judgment for the defendant.

Chasar Patents 994 and 207

We have little difficulty in concluding that the challenged devices in both of these patents are invalid for obviousness. The tests for obviousness were described in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966) as follows:

> Under § 103, the scope and content of the prior art are to be determined: differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. 383 U.S. at 17, 86 S. Ct. at 694.

Accord, *Reeves Brothers, Inc. v. U. S. Laminating Corp.*, 417 F.2d 869 (2 Cir. 1969). Citing a prior Chasar patent (3,132,753) and a British patent (British Sterling Patent No. 866,107), Hartman argues, we think convincingly, that the dual command and bin reject elements of Chasar 994 were amply foreshadowed in the prior art. Applications seeking grants of these two patents were pending at the time the application which matured into Chasar 994 was filed, and there is no doubt that they are relevant prior art.[2] Moreover, inasmuch as neither of these pending applica-

[2] *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252, 86 S. Ct. 335, 15 L. Ed. 2d 304 (1965); *Reeves Brothers, Inc. v. U.S. Laminating Corp.*, 417 F.2d 869, 871 n. 4 (2 Cir. 1969). Inasmuch as there is no evidence that the invention contained in Chasar 994 occurred prior to the filing date we measure the prior art from that date. See *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 46 S. Ct. 324, 70 L. Ed. 651 (1926). Both the British Sterling patent and Chasar 753 were pending in the Patent Office at the time the Chasar 994 application was submitted. We also note that a patent of an inventor may be part of the relevant art existing at the time of a subsequent application of the same inventor. See *Pierce v. Allen B. DuMont Laboratories, Inc.*, 297 F.2d 323 (3 Cir. 1961), cert. denied, 371 U.S. 814, 83 S. Ct. 24, 9 L. Ed. 2d 55 (1962); *Application of Jaegern*, 241 F.2d 723, 44 C.C.P.A. 767 (1957); *In re Land*, 109 F.2d 246, 27 C.C.P.A. 863 (1940).

tions is disclosed in the file wrapper of Chasar 994 the ordinary presumption in favor of the validity of a granted patent is severely undercut. See, *e. g., Lemelson v. Topper Corporation*, 450 F.2d 845 (2 Cir. 1971), cert. denied, 405 U.S. 989, 92 S. Ct. 1253, 31 L. Ed. 2d 456 (1972); *Reeves Brothers, Inc. v. United States Laminating Corp., supra*, 417 F.2d at 872; *Continental Can Co. v. Old Dominion Box Co.*, 393 F.2d 321, 326 n. 8 (2 Cir. 1968); *Formal Fashions, Inc. v. Braiman Bows, Inc.*, 369 F.2d 536, 539 (2 Cir. 1966). Also, close reading of the British patent seems to disclose the precise dual command mechanism which is claimed in the plaintiff's challenged patent.[3] In Sterling the "transporter" and "hoist" seem to have the capability of depositing one load and collecting another load prior to returning to the ground floor. The earlier Chasar patent (753) discloses the same storage-retrieval machine as the one claimed in the challenged Chasar patent, and, when these two patents are read together, the conclusion seems inescapable that the dual command

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[3] Claim 1 reads as follows:

A storehouse for goods comprising a structure divided into a number of storage floors each having storage slots to receive goods, a hoist for raising and lowering goods to and from the different storage floors, a transporter for moving the goods horizontally between the hoist and the storage slots, an electrically controlled director adapted to control automatically a "deposit" or "collect" cycle of operations as required including the steps of controlling the movement of the hoist and the transporter to a position at the selected floor opposite to the selected slot and depositing or collecting goods at or from the selected slot and conveyor means operable to move the goods into or out of the selected slot as required, depending upon whether the electrically controlled director has initiated a "collect" or "deposit" cycle, *the electrically controlled director being so arranged that if, during a "deposit" cycle, instructions are registered to collect from any slot other than that to which deposit is being made, the transporter after completing the deposit operation, will be operated under the control of the electrical director to carry out a "collect" operation without having to return to the ground floor first.* (Emphasis added)

disclose the invention to a person skilled in the art; and that the claims were not patentable over the prior art. After a careful assaying of these arguments we disagree, and we find that Lemelson 501 is valid. Admittedly, the Lemelson application, Serial No. 449,874, first filed on July 28, 1954, had a difficult time in the Patent Office. From the filing date until October 30, 1959 the Examiner, in five separate official actions, refused to grant the patent, essentially because the disclosure of the electrical system which was to control the stacker failed to provide sufficient specificity as to its component parts and its design to comply with the patent statute (35 U.S.C. § 112).[6] To remedy this defect Lemelson amended his application in 1959 by filing a new drawing, Figure 25, "to show a basic electrical circuit used in the automatic conveying system." In the official action of April 28, 1960, almost six years after the application was originally filed, the Examiner admitted Figure 25 as a part of the application. However, even then the application was still not completely acceptable and, after an interview with the Examiner, Lemelson decided to submit, and finally did submit, a new application dated October 10, 1961. This application, which was given Serial No. 145,013, was intended to be a continuation of the prior application and to have the benefit of the earlier filing date of the prior application. See 35 U.S.C.

(Continued from previous page)

and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

[6] For example, in the second official action (Paper No. 5, October 11, 1956, page 3) the Examiner stated: "No complete electrical circuit has been shown in the drawings that would provide for 'automatic' operation, nor is the specification an aid in this regard." This would appear to be indictive of the Examiner's reason for rejecting the application on all occasions.

§ 120.[7] The drawing in this new 1961 application setting forth the electrical circuit was identical to Figure 25 of the 1959 amendment to the prior application except that reference numbers were added. After some additional delays and further amendments the application Serial No. 145,013 was finally approved by the Examiner. It matured into Lemelson 501 as of January 28, 1964.

Defendant argues that inasmuch as the Examiner found that the disclosures of application 449,874 (the original application) were "incomplete" prior to the introduction of Figure 25 in 1959, Figure 25 must have been "new matter" which embodied invention outside the bounds of the original application. However, this argument overlooks the fact that an amendment to an application is not "new matter" within the Patent Act or Rules of the Patent Office unless it discloses "an invention, process or apparatus not theretofore described." *Reeves Brothers, Inc. v. U. S. Laminating Corp.*, 282 F. Supp. 118, 130 (EDNY 1968), affirmed, 417 F.2d 869 (2 Cir. 1969); accord, *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 57, 59 S. Ct. 8, 83 L. Ed. 34 (1938). If the later-submitted material accused of being "new matter" simply clarifies or completes the prior disclosure it cannot be treated as "new matter." See *Application of Wright*, 343 F.2d 761, 52 C.C.P.A. 1185 (1965); *H. H. Robertson v. Klauer Mfg. Co.*, 98 F.2d 150, 152-153

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[7] § 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

(8 Cir. 1938); *Lee v. Congress Beauty Equipment Co.*, 48 F. Supp. 827 (D. Mass.1943). Moreover, the determination of the Patent Office to admit the later-submitted material, thereby signifying that the Patent Office does not consider it to be "new matter," is presumptively correct. See *Helms Products, Inc. v. Lake Shore Mfg. Co.*, 227 F.2d 677 (7 Cir. 1955); *Baldwin-Lima-Hamilton Corp. v. Tatnall Measuring Systems Co.*, 169 F. Supp. 1 (E.D. Pa. 1958), affirmed, 268 F.2d 395 (3 Cir. 1959), cert. denied, 361 U.S. 894, 80 S. Ct. 190, 4 L. Ed. 2d 151 (1959). We think Figure 25 was a clarifying amendment rather than an amendment which disclosed "an invention, process, or apparatus not theretofore described." *Reeves Brothers, Inc. v. U. S. Laminating Corp., supra*, 282 F. Supp. at 130. The Examiner, after very careful consideration, decided to admit Figure 25, and Hartman has not presented us with any convincing evidence to rebut the presumption that the Examiner's decision was correct. See *Power Curbers, Inc. v. E. D. Etnyre & Co.*, 298 F.2d 484, 493 (4 Cir. 1962); *Manville Boiler Co. v. Columbia Boiler Co. of Pottstown*, 269 F.2d 600, 604, 605 (4 Cir. 1959), cert. denied, 361 U.S. 901, 80 S. Ct. 208, 4 L. Ed. 2d 156 (1959).

Hartman also contends that the Lemelson patent is invalid under 35 U.S.C. § 112 for incomplete disclosure. Hartman's argument is based on the fact that at trial Dr. Ronald G. Schultz, a Triax expert witness, in order to explain fully the operation of the Triax device, had to produce additional drawings of his own making which were not disclosed in the patent. Dr. Schultz did prepare some of his own drawings for use in court, but he did so only for the purpose of explaining the Triax system to the court. He did not say at any time that a man who possessed ordinary skill in the art could not make and use

the invention by recourse to the disclosures contained in the patent. To the contrary, he specifically testified that everything embodied in his drawings came from the description disclosures contained within the Lemelson patent. Accordingly, Hartman's argument that the disclosures were inadequate is clearly without merit and we reject it.

We also reject Hartman's contention that Triax could not have the benefit of the original application's filing date of July 28, 1954 for purposes of measuring patentability.[8] Under 35 U.S.C. § 120, if the later application refers to the earlier one and contains the same basic information, it is entitled to the earlier filing date for purposes of its patentability in relation to relevant prior art. See *Acme Highways Products Corp. v. D. S. Brown Co.*, 431 F.2d 1074 (6 Cir. 1970), cert. denied, 401 U.S. 956, 91 S. Ct. 977, 28 L. Ed. 2d 239 (1971). As we have mentioned earlier, Hartman has not provided this court with any convincing evidence to support its apparent position that the 1961 application discloses matter not disclosed in the earlier 1954 application. To the extent that Figure 25, discussed above, is the "new matter" Hartman claims disentitles the later application to the earlier filing date, we reject Hartman's argument, for we find Figure 25 not to be "new matter." Furthermore, we know of no further reason, and Hartman has not provided us with any, to believe that the later application should not be considered a continuation-in-part of the earlier application. Accordingly, we think prior art should be measured as of the 1954 filing

[8] The Burke U.S. Patent No. 2,941,738 granted on June 21, 1960 on an application filed on June 12, 1958, the French Sterling Patent No. 1,227,258, a companion of the British Sterling, granted on October 6, 1960 on an application filed on December 19, 1958, and the British Sterling Patent, granted on April 26, 1961 on an application filed December 20, 1957, all claim features which would have arguably made the Lemelson 501 in 1964 obvious to one with ordinary skill in the art. Therefore, it is important for Lemelson to have the benefit of the 1954 filing date.

date, at which time the Lemelson invention was clearly patentable. We find the Lemelson patent valid.

Do the Hartman Apparatuses Infringe?

In support of its claim that the Hartman stacker infringes the Lemelson patent Triax maintains that the design and operation of the Hartman stacker is so similar to the design and operation of its own stacker that the two machines are, in effect, equivalent, and therefore the Hartman machine infringes the Lemelson patent under the well established "doctrine of equivalents." Determining whether, vel non, the doctrine of equivalents applies to a given set of facts has never been, for obvious reasons, an easy matter for court resolution. The broadly stated test, enunciated in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608, 70 S. Ct. 854, 94 L. Ed. 1097 (1950), quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 50 S. Ct. 9, 74 L. Ed. 147 (1929), is whether the challenged device "performs substantially the same function in substantially the same way to obtain the same result" as the challenging device. In applying this test the court is guided by a corollary rule, soundly developed from the sensible proposition that some inventions by their very nature deserve slightly more extensive legal protection than others—the rule that, if a patent is a pioneering patent the patentee is allowed a wide range of equivalents, but if the patent is a narrow patent or the art is crowded the patentee is only allowed a correspondingly narrower range. See *Parmelee Pharmaceutical Company v. Zink*, 285 F.2d 465 (8 Cir. 1961). Furthermore, a factual finding by the lower court that a particular device is or is not equivalent to another device is not to be disturbed by appellate judges unless that finding is clearly unsupported by the trial record. See *Graver Tank & Mfg. Co. v.*

Linde Air Products Co., supra; Parmelee Pharmaceutical Company v. Zink, supra.

Upon our close examination of the record relative to the two stackers here involved we cannot say that the district judge's finding of non-infringement was clearly erroneous. Rule 52, Fed. R. Civ. P. In reaching this conclusion we note substantial differences between the Hartman stacker and the Triax stacker.

First, there are differences in design between the two machines. Triax claims a laterally *extended* fixture which juts out from the frame of the stacker and which supports and carries the load. Resembling a laterally extending fork apparatus, it is attached to the frame of the stacker's elevator carriage so that the fixture can move vertically as this carriage moves up and down the mast. Inasmuch as the fixture *always projects laterally* from the stacker the aisleway between the storage racks in which the stacker moves must be wide enough to accommodate the distance of this lateral projection. Also, although the fixture automatically moves into and out of the storage bins when it retrieves or deposits a load, the frame of the stacker to which the fixture is attached moves together with the fixture as the fixture moves. Because the fixture projects laterally from one side of the stacker, the stacker can only service one side of the aisleway at a time. In order for the Triax apparatus to service both sides of an aisleway its stacker would either need to have fixtures extending from both sides of the stacker—thus necessitating an even wider aisleway—or it would need to provide the means for rotating the stackers—which means are not claimed in the Lemelson patent.

In contrast to the Triax machine, the Hartman stacker has a laterally *extensible* apparatus which is normally housed *within* the elevator and which does *not* always project laterally. When the apparatus (extractor)

deposits a load into a bin, or retrieves a load from a bin, it moves outwardly and, unlike the Triax apparatus, the frame of the stacker does not also move. The Hartman stacker can extend laterally in either direction so that both sides of the aisleway can be serviced without rotating the stacker. Moreover, since the extractor is normally housed within the elevator, the aisleway need not be wide enough to accommodate the distance it occupies when the extractor is extended.

Second, there are operational differences between the two machines. In Hartman the elevator carriage on the stacker moves vertically up the mast to the proper height while the stacker is proceeding down the aisleway. This mode of operation caused Judge Burke to state that, as the Hartman carrier simultaneously travels both horizontally and vertically, the load carried by the carrier, if observed from the vantage point of the bin into which it is to be deposited, appears to move horizontally toward that bin. In contrast, the Triax stacker moves down the aisleway to the programmed position and stops; after it stops this horizontal motion the stacker's carriage moves vertically up the mast to the level of the proper bin. The two systems also differ in the electrical means used to control the stopping of the vertical movement of the stacker at the proper bin. The Lemelson patent claims "means on the storage rack for identifying the relative positions" of the bins. The Triax system has "reflective markers" placed at each bin on each storage rack which are scanned by photoelectric scanners on the self-propelled elevator carriage. By contrast, the bin position at which the Hartman load carrier is to stop is determined by an electrical control of pins on an endless chain that raises or lowers the elevator. The chain and pins are carried by the Hartman stacker and engage and trip a switch on the Hartman stacker's mast to stop the vertical movement of the eleva-

tor at the pre-selected bin. Because of the diagonal motion of the Hartman load it would be impossible for Hartman to use "reflective markers" on a storage rack.[9] Also, Hartman differs from Lemelson in the way in which the horizontal movement of the stacker down the aisleway is controlled. In Lemelson the stacker is guided by a "predetermining counting" mechanism which, upon receipt of a predetermined number of position-indicating signals, "uncounts" to stop the drive means. By contrast, the Hartman stacker's position longitudinally down the aisleway is determined through the engaging by a switch on the stacker of a series of transverse bars between opposed storage rack frames.

Lemelson is not a "pioneering patent,"[10] and we have no hesitancy in concluding that its range of equivalents is

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[9] This finding appears in the lower court's opinion as Finding 6:

> Hartman's load carrier has a diagonal motion in travelling to a bin to deposit or to pick up a load. It does not travel horizontally first, then stop, and then travel vertically to the selected bin and stop. It simultaneously travels horizontally and vertically. Because of this diagonal motion it is impossible for Hartman to use means on the storage racks for identifying the relative positions of the storage bays, because of the different angles presented by diagonal travel.

[10] The Lontz Patent, granted on October 12, 1954, cited in Lemelson, claims certain features which lead us to conclude that Lemelson was not a pioneer. For example, Claim 1 of Lontz reads as follows:

> 1. In a storage system having a plurality of serially arranged storage compartments and a loading station; a conveyor movable between said station and compartments, said conveyor including means for engaging loads in said loading station and depositing the loads in said compartments, actuating means energizable for moving said conveyor, control means for controlling the energization of said actuating means and having a plurality of conveyor energized positions, one for each said compartment, and a single conveyor de-energized position, means for initially positioning said control means in one of its conveyor energized positions and for then establishing an energizing circuit for said actuating means, means operable by movement

(Footnote continued on following page)

relatively narrow. The differences between the Triax and Hartman apparatuses, considered individually, might not be of sufficient importance or magnitude to save Hartman's apparatus from the reach of even the narrow range of equivalents assigned to Lemelson, but when the differences are taken as a bundle and are considered in the context of the apparently increased capabilities and improved performance of Hartman, we hold that they are. In reaching this conclusion we fully recognize that the question of whether particular differences between a challenged device and a device enjoying patent protection are sufficient to carry the challenged device outside the range of equivalents of the patented device is one "[on which] courts have differed and always will differ" (*Royal Typewriter Co. v. Remington Rand*, 168 F.2d 691 (2 Cir. 1948) (L. Hand, J.), cert. denied, 335 U.S. 825, 69 S. Ct. 50, 93 L. Ed. 379 (1948)). However, upon a final analysis here, we think it can fairly be said that the Hartman machine, although it performs substantially the same function as the Triax machine, does not perform it in "substantially the same way," see *Graver Tank & Mfg. Co. v. Linde Air Products Co., supra*, and that, in any event, the finding of noninfringement by the district court was not "clearly erroneous." Rule 52, Fed. R. Civ. P.

Judgment affirmed.

(Continued from previous page)

of said conveyor past the compartments intervening between the loading station and the selected one of said compartments corresponding to the said one position of said control means for returning the control means step by step to its conveyor de-energized position, and a cycle controller operable to cause said conveyor first to engage a load in said loading station, then to move under the influence of said actuating means into the said one compartment, then to deposit the load in the said compartment, and, lastly, to return to said loading station, all during a single integrated cycle.

We think the concept expressed in this Claim precludes a finding that Lemelson was a pioneer.

III. JUDGMENT ENTERED BY THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Nos. 35, 36, Dockets 71-1843, 71-1978

UNITED STATES COURT OF APPEALS
SECOND CIRCUIT

THE TRIAX COMPANY
Plaintiff-Appellant,

v.

HARTMAN METAL FABRICATORS, INC.
Defendant-Appellee

Judgment affirmed.

Enter:
May 31, 1973.

IV. ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT DENYING REHEARING

Docket Nos. 71-1843, 71-1978

UNITED STATES COURT OF APPEALS
SECOND CIRCUIT

At a stated term of the United States Court of Appeals, in and for the Second Circuit held at the United States Court House, in the City of New York, on the twenty-third day of July, one thousand nine hundred and seventy-three.

Present:

HON. STERRY R. WATERMAN
HON. HENRY J. FRIENDLY
PAUL R. HAYS,
Circuit Judges.

THE TRIAX COMPANY,
Plaintiff-Appellant,

v.

HARTMAN METAL FABRICATORS, INC.
Defendant-Appellee

A petition for a rehearing having been filed herein by counsel for the appellant,

Upon consideration thereof, it is

Ordered that said petition be and it hereby is denied.

A. DANIEL FUSARO
Clerk

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FILED
NOV 8 1973
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1973

No. 73-670

THE TRIAX COMPANY,
Petitioner,

v.

HARTMAN METAL FABRICATORS, INC.,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

To The United States Court of Appeals
For the Second Circuit

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November 7, 1973.

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IN THE

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No. 73-670

THE TRIAX COMPANY,

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HARTMAN METAL FABRICATORS, INC.,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI
To The United States Court of Appeals
For the Second Circuit

Petitioner bases its principal argument for grant of a writ of certiorari on the contentions:

a) that the Court of Appeals erroneously supposed a prior Chasar patent (No. 3,132,753) and a British patent to Stirling (No. 866,107) were not disclosed in the file wrapper of the Chasar dual command patent (No. 3,139,994), and

b) that the Court of Appeals erroneously supposed the earlier Chasar patent (No. 3,132,753) discloses the same storage-retrieval machine as that disclosed in the Chasar patent No. 3,139,994.

Argument

a) The first above-mentioned contention of Petitioner is based upon a narrow and unwarranted interpretation of the language of the Court of Appeals decision. The Court of Appeals in its decision was pointing out that the Patent Office Examiner in his examination of the patent application, which matured into Patent No. 3,139,994, did not *cite* against that application the prior Chasar Patent No. 3,132,753, and that therefore the presumption of validity of Patent No. 3,139,994 is severely undercut. As a matter of fact all that the Examiner did was to admonish Chasar (PX45, p. 212) in the early stages of prosecution of the application that matured into Patent No. 3,139,994, to maintain a proper line of distinction between the claims of that application and those of the copending application that subsequently matured into Chasar Patent No. 3,132,753. After that the Examiner ignored the application which matured into the '753 patent, and the '753 patent itself. Patent No. 3,132,753 is not even included among the 27 references listed at the end of Patent No. 3,139,994 (PX1, R. Vol. II, p. 53) as *cited* in the file of this patent. The contention of Petitioner that the Court of Appeals was in error as regards Chasar Patent No. 3,132,753 therefore is not supported by the file wrapper of the Chasar Patent No. 3,139,994 itself.

It is true that the French Stirling Patent No. 1,227,258 shows the equivalent of the British Patent No. 866,107 and was cited by the Examiner during the pendency of the application which matured into Patent No. 3,139,994; but the French patent was not cited until the final office action in that application, and even then was not used to reject any claims (PX45, p. 235, R. Vol. II, p. 262). It would appear that the Examiner did not fully appreciate the disclosure of that French patent since it was in French, not English.

In any event the Court of Appeals has considered the Chasar dual command Patent No. 3,139,994 *in view of* the Chasar Patent No. 3,132,753 and the Stirling British Patent No. 866,107 *in combination* and has held that in view of these two patents ". . . the conclusion seems inescapable that the dual command means was obvious to anyone with ordinary skill in the art." (A 16, 17).

35 U. S. C. 103, Conditions for Patentability: Non-Obvious Subject Matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *" July 19, 1952, c. 950, § 1, 66 Stat. 798.

b) As regards the contention of the Petitioner that the Court of Appeals erroneously supposed the earlier Chasar '753 patent discloses the same storage-retrieval machine as that disclosed in the Chasar '994 patent, all we need do is to point to Chasar's own statement with respect to the relation between the disclosures of these two patents. Chasar says (column 3, lines 24 to 35 of the '994 patent):

> "While the present invention might be adapted to various apparatus or uses, it has been chosen to show the same for mechanical storage equipment taking the form of a load transfer and storage apparatus *substantially the same in structure as* that *disclosed in my copending United States patent application, Serial No. 813,585*, filed May 15, 1959 by Anthony R. Chasar and Walter F. Double . . . to which reference may be had

> for further disclosure, if necessary, to more clearly understand the present invention and to complete the present disclosure" (emphasis added) (PX1, R. Vol. II, p. 22)

Application Serial No. 813,585 matured into the Chasar '753 patent.

Petitioner's own statement made at the time of filing of the application that matured into the Chasar '994 patent, and contained in the '994 patent itself therefore *completely refutes* Petitioner's present contention that the Court of Appeals erroneously supposed the earlier Chasar '753 patent discloses the same storage-retrieval machine as that disclosed in the Chasar '994 patent.

The Presumption of Validity Is Only a Presumption

The presumption of validity of a patent (35 U. S. C. 282) is only a presumption; and the grant of a patent by the Patent Office is no absolute guarantee of its validity.

The Court of Appeals has found the alleged invention of Patent No. 3,139,994 obvious on a ground not considered by the Patent Examiner.

Patent No. 3,139,994 claims a load transfer apparatus in which a load can be taken from a load station by a load carrier and stored in a bin of a storage rack, and thereafter the return trip of the load carrier to the load station is interrupted and the load carrier is sent to another bin of the rack to remove a load from the latter bin and carry that load to the load station. The prior Chasar Patent No. 3,132,753 could be programmed either to carry a load from the load station to store the load in a bin of the storage

rack or to go to a bin of a storage rack, take a load therefrom and bring that load to the load station. We submit that if it was desired to deposit a load in one bin and to take another load from another bin, anyone with horse sense would know enough to interrupt the return of the carrier to the load station after depositing a load and send the carrier on to the other bin to pick up the other load. There was no invention, therefore, in Patent No. 3,139,994 over the disclosure of Patent No. 3,132,753: Patent No. 3,132,753 discloses the basic storage retrieval mechanism claimed in Patent No. 3,139,994. But aside from this, British Patent No. 866,107 discloses dual command apparatus for transferring a load from a load station to a bin and thereafter going to another bin to pick up a load before returning to the load station. The Court of Appeals therefore was right in holding that the dual command means of Patent No. 3,139,994 "was obvious to anyone with ordinary skill in the art".

Patent No. 3,139,994 Was Not a Pioneering Patent

In the first paragraph on Page 4 of Petitioner's Petition, Petitioner seems to imply that the development of equipment to store materials automatically started with it in 1959 and with its Patent No. 3,139,994. The Lemelson Patent No. 3,119,501 (one of three patents involved in this litigation) belies this. It discloses automatically-operating storage equipment; and the application from which it matured was filed July 28, 1954, more than six years before the application that matured into Patent No. 3,139,994 was filed.

There Is No Basis For Issuance of a Writ of Certiorari

The question here involved is a mere matter of patentability. The Court of Appeals decision is not in conflict with the decision of another court of appeals. It has not decided an important question of federal law which had not been, but should be settled by this Court; nor has it decided a federal question in a way in conflict with applicable decisions of this Court; nor has it so far departed from the accepted and usual course of judical decisions as to call for an exercise of this Court's power of supervision (Rule 19 (b), Rules of the Supreme Court of the United States).

Conclusion

For the above reasons it is submitted the Petition should be denied.

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